

## REMARKS

At the time of the Office Action dated August 25, 2010, claims 2-6 were pending in this application. In this Amendment, claims 2-4 have been amended, and claim 5 canceled. Care has been exercised to avoid the introduction of new matter. Support for the amendments to the claims can be found in, for example, paragraphs [0047], [0048], [0050]-[0054], and [0064]-[0066] of the specification.

Claims 2-4 and 6 are pending in this application, of which claims 2-4 are independent.

### **Claim Rejection under 35 U.S.C. § 103**

Claims 2-4 have been rejected under 35 U.S.C. § 103(a) as being unpatentable over Watkins et al. (U.S. Patent No. 6,507,672, hereinafter "Watkins"). Dependent claim 5 has been canceled, but independent claim 2-4 recite the limitations of the claim.

Watkins does not disclose or suggest an image coding apparatus including all the limitations recited in independent claims 2-4, as amended. With respect to claim 2, the reference does not teach, among other things, the following limitations recited in the claim:

a reference mode selection circuit which sets selectively either a reference mode that uses a bidirectional coding in which a past frame and a future frame are referred to or a reference mode that does not use the bidirectional coding, as the inter-frame coding scheme, according to a table associating a first resolution of an image with one of the reference modes and a second resolution of an image with the other reference mode, the table varying based on an coding execution environment in said apparatus, the second resolution being higher than the first resolution,

wherein said reference mode selection circuit obtains image resolution information, and referring to the table, sets the reference mode that uses the bidirectional coding when an image represented by the image signal to be coded has the first resolution, and sets the reference mode that does not use the bidirectional coding when the image represented by the image signal to be coded has the second resolution,

said coding circuit codes the image signal by using a scheme complying with MPEG,

in the reference mode that uses a bidirectional coding, the coding is performed using I pictures, P pictures and B pictures, and

in the reference mode that does not use the bidirectional coding, I pictures and P pictures are used.

In the Office Action, the Examiner admitted that Watkins fails to disclose the claimed reference mode selection circuit. However, the Examiner asserted as follows (the paragraph bridging between pages 3 and 4 of the Office Action):

Depending on the processor capability, the motion estimation of B-frame cannot be done in real time for High resolution pictures which requires more computation than low resolution picture, even though it is possible in the low resolution pictures. In this case, it was obvious to the ordinary person in the art that the reference mode is selected such that the bidirectional coding is not used for high resolution and bidirectional coding is used for low resolution, in order to encode the images in real time.

The Examiner further asserted “inherent in Watkins because Watkins has a choice of encoding without B frame” (the first paragraph on page 8 of the Office Action).

The Examiner appears to heavily rely on the doctrine of inherency to assert that the claimed reference mode selection circuit is taught by Watkins. However, Applicants submit that the Examiner did not discharge the initial burden of establishing a *prima facie* basis to deny patentability to the claimed subject matter under 35 U.S.C. §103 for obviousness, and that the Examiner's reliance upon the doctrine of inherency is misplaced.

In order to rely upon the doctrine of inherency, the Examiner is required to identify a factual basis upon which to predicate the determination that an allegedly inherent feature would necessarily flow from the teachings of the applied prior art. *Finnegan Corp. v. ITC*, 180 F.3d 1354, 51 USPQ2d 1001 (Fed. Cir. 1999); *In re Robertson*, 169 F.3d 743, 49 USPQ2d 1949 (Fed.

Cir. 1999). The Honorable Board of Patent Appeals and Interferences in *ex parte Schricker*, 56 USPQ2d 1723, 1725 (BPAI 2000) held as follows:

However, when an examiner relies on inherency, it is incumbent on the examiner to point to the "page and line" of the prior art which justifies an inherency theory. *Compare, In re Rijckaert*, 9 F.3d 1531, 1533, 28 USPQ2d 1955, 1957 (Fed. Cir. 1993) (when the PTO asserts that there is an explicit or implicit teaching or suggestion in the prior art, it must indicate where such a teaching or suggestion appears in the prior art); *In re Yates*, 663 F.2d 1054, 107, 211 USPQ 1149, 1151 (CCPA 1981).

The Examiner did not discharge that burden because the Examiner has not yet shown any evidence supporting his inherency theory. Accordingly, Applicants submit that the Examiner's assertion that "Watkins has a choice of encoding without B frame" (see the first full paragraph on page 8 of the Office Action) is not reasonable, and thus Watkins does not teach, among other things, "in the reference mode that does not use the bidirectional coding, I pictures and P pictures are used," recited in claim 2.

Further, Applicants emphasize that Watkins does not teach how to implement "a choice of encoding without B frame." Specifically, the reference does not teach, among other things, the claimed reference mode selection circuit which sets a reference mode "according to a table associating a first resolution of an image with one of the modes and a second resolution of an image with the other mode, the table varying based on an coding execution environment in said apparatus," and "obtains image resolution information and referring to the table, sets the reference mode...."

Applicants reviewed Watkins and found that the reference does not teach the claimed table to be used for selection of the reference mode and does not teach obtaining image resolution information for selection of the reference mode. Therefore, Watkins does not teach, among other things, the claimed reference mode selection circuit.

Based on the foregoing, Watkins does not disclose or suggest an image coding apparatus including all the limitations recited in independent claim 2.

The above discussion is applicable to independent claims 3 and 4 because the Examiner's rationale for rejecting these claims are similar to that of independent claim 2, and claims 3 and 4 recite limitations similar to the above-discussed limitations of independent claim 2. For example, Watkins does not teach, among other things, the claimed reference mode selection circuit which sets a reference mode "according to a table associating a first frame rate with one of the reference modes and a second frame rate with the other reference mode, the table varying based on an coding execution environment in said apparatus, and "obtains frame rate information" for setting the reference mode based on the table, as recited in claim 3. Watkins does not also teach, among other things, the claimed reference mode selection circuit which sets a reference mode "according to a table associating a first bit rate with one of the reference modes and a second bit rate with the other reference mode, the table varying based on an coding execution environment in said apparatus, and "obtains bit rate information" for setting the reference mode based on the table, as recited in claim 4. Accordingly, Watkins does not disclose or suggest an image coding apparatus including all the limitations recited in independent claims 3 and 4.

Claim 6 is also patentably distinguishable over Watkins at least because the claim includes all the limitations as recited in independent claim 2.

Applicants, therefore, respectfully solicit withdrawal of the rejection of the claims and favorable reconsideration thereof.

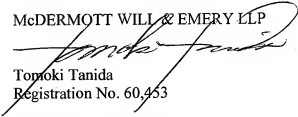
**Conclusion**

In view of the above amendments and remarks, Applicants submit that this application should be allowed and the case passed to issue. If there are any questions regarding this Amendment or the application in general, a telephone call to the undersigned would be appreciated to expedite the prosecution of the application.

To the extent necessary, a petition for an extension of time under 37 C.F.R. 1.136 is hereby made. Please charge any shortage in fees due in connection with the filing of this paper, including extension of time fees, to Deposit Account 500417 and please credit any excess fees to such deposit account.

Respectfully submitted,

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